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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,533	09/28/2001	Russell F. Mcknight	P1733US00	4798

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EXAMINER

DEANE JR, WILLIAM J

ART UNIT PAPER NUMBER

2614

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/966,533	Applicant(s) MCKNIGHT, RUSSELL F.	
	Examiner William J. Deane	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1 page</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,631,188 (Sands) in view of U.S. Patent Application No. 2002/0131565 (Scheuring et al.).

With respect to claims 1 - 2, 4, 10 - 12, 14 - 15, 19 and 22 - 26 note that Sands teaches a caller ID unit for identifying caller information associated with an incoming call (see Fig. 5), and scheduling means for a call-back (Abstract).

With respect to the caller ID means it would have been obvious to one of ordinary skill in the art to have incorporated the caller ID device into the phone 12 as such only entail putting two separate devices used together and incorporating them into one device.

With further respect to the scheduling means and the limitations of claims 4, 14, 19 and 22 - 23, note Fig. 1 of Scheuring et al. and paragraphs 0077 and 0078 of Scheuring et al. It would have been obvious to one of ordinary skill in the art to have incorporated such a scheduling means as taught by Scheuring et al. into the Sands system as such would only entail the substitution of one scheduling means for another.

With respect to claim 3, note Fig. 1 of Sands.

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With respect to claim 5, note Abstract.

With respect to claim 6, note Abstract and controls (40) of Sands.

With respect to claim 7, note telephone 12 of Sands.

With respect to claim 8, note storage device 26 of Sands.

With respect to claim 9, note storage device 28 of Sands.

With respect to claim 13, note elements 42 and 44 of Sands.

With respect to claims 16 - 18, note telephone 12 and caller ID unit 22. The other means cited would be obvious in view of Sands and the other art cited prior art cited throughout the prosecution of the case.

With respect to claim 21, note that, as broadly claimed, telephone 12 is a portable handheld device.

Response to Arguments

Applicant's arguments with respect to claims 1 - 26 have been considered but are not deemed persuasive to any error in the rejection above.

First, applicant contends that there is no motivation to combine the caller ID unit and the telephone both elements included in the Sands reference. Both are at the users premise and to put the two together would be obvious to one of ordinary skill in the art and not patentable. This is in particularly true in light of the Scheuring et al. reference where a caller identifying means is included in the user's customer premise equipment (CPE) (see Fig. 1 and steps 420 and 430 in Fig. 4). In fact, the examiner could call the phone and caller ID unit in Sands the CPE.

Second, it is argued that there is nothing in Sands, which would allow one to carry on a telephone conversation as well as schedule, by the user a callback based on identified call information. However, the instant claims are not written in such a way as to convey such an idea. For example, claim one is written in such away that it does not convey that the calling party stays on the line while the scheduling is going on. How does continuing the call relate to the scheduling means? For instance, does the system have a voice recognition system so during the call when a user says I will have to call you back at 5 O'clock tomorrow the system calls up the scheduling program and without anything more and schedules the call? If so, such is not claimed.

The instant claims are so broad as read on the following scenario: a user is called on a system having VoIP and caller ID (like Internet call waiting), the user while talking clicks his calendar and schedules a date and time to call the caller back. There is not even a limitation that the instant claim 1 recites that says that at the appointed date and time the system automatically calls back the earlier calling party.

Applicant also argues that Sands does not allow one to schedule a callback after receiving the call, however this is not entirely true. Even in Sands the callback is not scheduled until after receiving the call. The call is received and the identified and then scheduled for a callback or some other routing like to voicemail. Even if applicant were to prevail on this point, the examiner was looking at the calendaring system in Scheuring et al, which allows for such an option. Again the claims are broad and in some cases ambiguous.

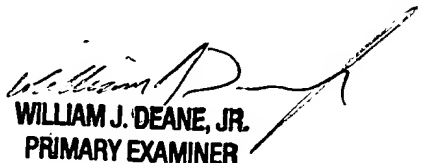
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (571) 272-7484. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 273-8300.

27Sep2006


WILLIAM J. DEANE, JR.
PRIMARY EXAMINER